

REMARKS

This paper responds to an Office Action dated November 19, 2003, which was a non-final action.

Claim Rejections Under 35 U.S.C. §§102(e)/103

The Office Action rejected claims 1-6 and 10-14 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,590,922 (Onkels) in view of a Centronic document. The Office Action stated that claims 7-9 and 15 would be allowable if rewritten in independent form.

The Onkels patent was issued on July 8, 2003, based on U.S. application 09/879,311 filed June 12, 2001. The Onkels application is a continuation-in-part of eight prior non-provisional U.S. applications filed between May 14, 2001 and September 27, 1999. The present application was filed on February 24, 2000, and claims domestic priority under 35 U.S.C. 119(e) based on provisional application 60/122,145 filed February 26, 1999.

Applicant traverses the rejection of claims 1-6 and 10-14 because the Onkels patent is not a prior art reference. The Office Action does not state or discuss the basis by which the Onkels patent is asserted to be prior art. In an exchange of telephone messages between the Examiner and the undersigned attorney attempting to clarify the grounds for the rejection, the Examiner stated that the Onkels patent is prior art because it has a priority date of September 1999, which is before the February 24, 2000 filing date of the present invention. Thus, the purported statutory basis for asserting the Onkels patent as prior art is 35 U.S.C. 102(e), but that provision is not satisfied for two reasons.

First, the Onkels patent is not a 102(e) reference because its effective filing date, June 12, 2001, is after the February 24, 2000 filing date of the present application. The application that resulted in the Onkels patent was a continuation-in-part of eight prior non-provisional applications, five of which were filed in 1999 (all of which resulted in issued U.S. patents) and three of which were filed in 2001. MPEP 2136.03 IV. is on point:

IV. PARENT'S FILING DATE WHEN REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT

Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph.

It is the Examiner's burden to establish a prima facie case that the Onkels patent has a 102(e) effective date earlier than its June 12, 2001 filing date of application 09/879,311. No such showing has been made. Moreover, since all five of the related applications filed in 1999 are issued U.S. patents, and since any of the five U.S. patents could have been but were not cited against the present application, one must conclude that none of the 1999 applications support the claims issued in the Onkels patent. The reference date of the Onkels patent is June 12, 2001, which is after the filing date of the present invention. Accordingly, the Onkels patent is not prior art under 35 U.S.C. 102(e) or 103.

Second, the Onkels patent is not a 102(e) reference against at least claims 1-2 and 5-12, which are entitled to the February 26, 1999 filing date of a provisional application that the present application claims priority under 35 USC 119(e). The present application claims priority under 35 U.S.C. 119(e) to provisional application 60/122,145, filed February 26, 1999. That provisional application supports at least claims 1-2 and 5-12 because the provisional application discloses and describes the elements of those claims. The earliest prior application related to the Onkels patent was filed on September 27, 1999, which is after the February 26, 1999 effective filing date of claims 1-2 and 5-12 of the present application. Accordingly, the Onkels patent is not prior art to at least claims 1-2 and 5-12. The rejection of those claims is improper and should be withdrawn.

Summary

Applicant objects to the rejections based on the Onkels patent for two reasons: (1) The filing date of the present application is February 24, 2000, which is before the June 12, 2001 effective filing date of the Onkels patent. The examiner has failed to set forth a prima facie case for an earlier 102(e) date for the Onkels patent. (2) Claims 1-2 and 5-12 of the present application are entitled to an effective filing date of February 26, 1999, which is prior to the earliest possible effective 102(e) date of the Onkels patent.

The conclusion that must follow is that the Onkels patent is not a prior art reference under 35 USC §102(e). The rejections are erroneous and must be withdrawn.

Conclusion

For all the reasons set forth above, Applicant requests reconsideration and withdrawal of the rejections stated in the November 19, 2003 Office Action.

Respectfully submitted,

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